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Paper No. 32

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OFFICE OF PETITIONS

ON PETITION

In re Application of
Go
Application No. 08/860,182
Filed: June 22, 1997
For: VEHICLE DOOR FOR CAR AND TRUCK

This is a decision on the letter regarding the above-identified application, mailed on September 10, 2001, which is being properly treated as a petition under 37 CFR 1.137(a) to revive this application ("9/10/01 Petition").

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within **TWO (2) MONTHS** from the mailing date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C. 704.

This application became abandoned on July 11, 2000 for failure to timely submit a proper reply to an April 10, 2000 non-final Office Action, which provided a 3-month shortened statutory reply period ("4/10/00 non-final Office Action").²

The most recent prosecution history for this application is as follows:

- A final Office action was mailed on February 10, 1999;³
- A CPA was filed on June 14, 1999 and a "second" final Office action was mailed on August 31, 1999 ("8/31/99 final Office Action");⁴

¹ Dated 4/6/00 but mailed 4/10/00.

² See 37 CFR 1.135(a) (If . . . an applicant fails to reply within the time period provided . . . , the application will become abandoned.); USPTO Manual of Patent Examination Procedure (MPEP), section 711.04(a) (Aug. 2001): "[T]he date of abandonment is after midnight of the date on which the set shortened statutory period, including any [obtained] extensions under 37 CFR 1.136, expired." [Note: The entire text of the current version of the MPEP is available online, via www.uspto.gov]

³ Paper No. 11.

⁴ Paper No. 19.

- Applicant timely filed a reply to the 8/31/99 final Office action,⁵ and the Examiner mailed an advisory letter on October 8, 1999 ("10/8/99 Letter"), requiring that an amended reply sufficiently understandable for examination be filed on or by November 8, 1999;⁶
- Applicant's amended reply, though also timely filed,⁷ was not responsive to the 10/8/99 Letter;⁸
- In lieu of holding the application abandoned as of November 9, 1999,⁹ the Examiner gave Applicant further opportunity to advance the application to final action by issuing the 4/10/00 non-final Office action;¹⁰
- Rather than responding to this Office action, Applicant requested an investigation of the prosecution of this application in a June 2, 2000 letter, which was treated as a petition under 37 CFR 1.181 to review the *ex parte* action by the Examiner ("6/2/00 Petition");
- A decision on the 6/2/00 Petition was mailed on July 26, 2001 ("7/26/01 Decision"), concluding that this application had become abandoned for failure to timely submit a proper reply to the 4/10/00 non-final Office Action;¹¹
- A Notice of Abandonment was mailed on August 1, 2001;
- The 9/10/01 Petition (letter) then followed.

To be grantable, a petition under 37 CFR 1.137(a) must be accompanied by:

- (1) the required reply, unless previously filed;¹²

⁵ 9/10/99: claims; 9/15/99: claims and substitute specification.

⁶ See Paper No. 22, page 2, 7th paragraph; and page 3, 3rd paragraph (The Examiner determined that the application was so replete with errors that more changes would be needed before another action on the merits could be issued).

⁷ 10/17/99 and 11/7/99; see 7/26/01 Decision, page 3, 4th paragraph.

⁸ 7/26/01 Decision, page 3, 4th paragraph.

⁹ 37 CFR 1.135(b) ([A]ny amendment not responsive to the last [Office] action . . . will not operate to save the application from abandonment); 37 CFR 1.111 (The applicant's reply must appear throughout to be a *bona fide* attempt to advance the application to final action.); MPEP section 711.02(a) (Aug. 2001): "Abandonment may result . . . where applicant's reply is within the period for reply but is not fully responsive to the Office action."

¹⁰ See Paper No. 26.

¹¹ See Paper No. 29.

¹² Generally, the required reply is the reply sufficient to have avoided abandonment, had it been timely filed; see MPEP section 711.03(c)(III)(A) (Aug. 2001). In the instant case, the required reply for reviving the application may be either: an amendment that appears to be *bona fide* attempt to advance the application to final action; or, the filing of a continuing application under 37 CFR 1.53(b), a continued prosecution application (CPA) under 37 CFR 1.53(d) (since the previous CPA on this application was filed

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- (2) the petition fee;¹³
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable,¹⁴ and
- (4) a terminal disclaimer and accompanying fee if the application was filed on or before June 8, 1995 or if the application is a design application.¹⁵

The instant petition appears to have satisfied the requirement in item (1) above by enclosing an amendment in reply to the 4/10/00 non-final Office action.¹⁶ However, as discussed below, this petition is dismissed for lacking item (3) above.

Analysis

In prosecuting a patent application, the applicant is required and is expected to exercise **diligence** generally observed by prudent and careful men in relation to their most important business.¹⁷ An

on 6/14/99, prior to 5/29/00). See MPEP 711.03(c)(III)(A)(2)(a) (Aug. 2001); 37 CFR 1.111(b); 65 FR 50093 (Aug. 16, 2000; efective Aug. 16, 2000).

¹³ The instant petition has included the \$55 petition fee (small entity).

¹⁴ See 35 U.S.C. 133, 37 CFR 1.137(a), and Douglas v. Manbeck, 21 U.S.P.Q.2d 1697; 1991 U.S. Dist. LEXIS 16404, 16412-13 (E.D. Pa. 1991); also see In re Takao, 1990 Dec. Comm'r Pat. 6, 16 (Comm'r Pat. 1990); 7 U.S.P.Q.2d 1155 ([T]he showing of unavoidable delay must embrace the period from the time the action by the Office requiring a response by applicant, to the time both the response and a showing of unavoidable delay acceptable to the Commissioner [are] filed). (citing Ex Parte Naef, 1905 Dec. Comm'r Pat. 121 (Comm'r Pat. 1905)) (emphasis added)

A deliberately chosen course of action to not respond to an Office action cannot reasonably be considered to amount to an unavoidable abandonment within the meaning of 37 CFR 1.137(a); intentional abandonment precludes revival under 37 CFR 1.137(a). See In re Maldaque, 1988 Dec. Comm'r Pat. 22, 25-26 (Comm'r Pat. 1988); 10 U.S.P.Q.2d 1477.

¹⁵ Not applicable to this application.

¹⁶ Where the proposed reply is to a non-final Office action, the petition may be granted if the reply appears to be *bona fide*. After revival of the application, the examiner may determine that the reply is lacking in some respect, and would send out a letter for correction of the errors or omissions. If applicant does not timely submit the corrections as required, the application is again abandoned. see MPEP 711.03(c)(III)(A)(2)(a) (Aug. 2001).

¹⁷ Haines v. Quigg, 673 F.Supp. 314, 317; 5 U.S.P.Q.2d 1130 (N.D. Id. 1987), citing Ex Parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887); also see In re Mattullath, 38 App. D.C. 497, 510-511; 1912 U.S. App. LEXIS 2157, 2177-78 (D.C. Cir. 1912) (The purpose and policy of the patent law are to give the patent to the first inventor, unless he has, by his own fault, subordinated his right to a more

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application becomes abandoned if the applicant fails to timely respond to an outstanding Office action.¹⁸ To request revival of an application so abandoned, the applicant must show due diligence in prosecuting the application, e.g., timely response to outstanding Office action as well as timely inquiry into the status of an application.¹⁹ The applicant also has the burden to show, to the satisfaction of the Commissioner, that the entire delay, including the delay that caused the abandonment and the delay in filing a grantable petition to revive, was "unavoidable" despite Applicant's exercise of due diligence.²⁰ Whether such a delay was or was not "unavoidable," within the meaning of 35 U.S.C. 133 and 37 CFR 1.137(a), is judged by the Commissioner on the basis of "reasonably prudent person" standard,²¹ on a case-by-case basis, taking into account all of the relevant facts and circumstances.²²

The petition asserts that "unavoidable" delay in replying to the 4/10/00 non-final Office Action resulted from Applicant's "confusion" when reading that Office action which, as alleged in the

diligent inventor . . . The question is . . . whether the representatives of [the inventor] had "slept upon their rights."); and at 514 (The word "unavoidable" is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business.); also, Winkler v. Ladd, 221 F.Supp 550, 553; 138 U.S.P.Q. 666 (D.D.C. 1963) ([P]laintiff has failed to prove that he exercised the diligence of a prudent and careful man in relation to important business within the meaning of Section 133).

¹⁸ 37 CFR 1.135.

¹⁹ Douglas v. Manbeck, note 14, *supra*, at 16414 (E.D. Pa. 1991), citing Futures Technology, Ltd. v. Quigg, 684 F. Supp. 430, 431; 7 U.S.P.Q.2d 1588 (E.D. Va. 1988); also see Takao, note 14, *supra*, at 13-14 (The patent law requires an applicant to prosecute a patent application with reasonable diligence . . . The diligence required pertains to the acts required of applicant to respond to any outstanding Office action or requirements so that the PTO can take appropriate action in completing the examination of the application.).

²⁰ Haines v. Quigg, note 17, *supra*, at 316 (The District Court for the Northern District of Indiana, South Bend Division, denied a patent applicant's motion for summary judgment to set aside the Commissioner's refusal to revive a patent application because the applicant has "failed to meet his burden of proof as stated in 35 U.S.C. 133 and 37 CFR 1.137(a)."); also see Krahm v. Commissioner, 15 U.S.P.Q.2d 1823; 1990 U.S. Dist. LEXIS 16741, 16745-6 (E.D. Va. 1990) (The test of unavoidable delay is the "reasonably prudent person" test set forth in In re Mattullath . . .).

²¹ Haines v. Quigg, note 17, *supra*, at 317.

²² Takao, note 14, *supra*, citing Smith v. Mossinghoff, 671 F.2d 533, 538; 217 U.S. App. D.C. 27 (D.C. Cir. 1982). Also see In re Application G, 1989 Dec. Comm'r Pat. 4, 9 (Comm'r Pat. 1989); 11 U.S.P.Q.2d 1378.

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instant petition, "contradicts" the 10/8/99 Letter.²³

As clearly summarized in the 7/26/01 Decision, the purpose of the 10/8/99 Letter was twofold: to advise Applicant that the September 1999 reply was so incomprehensible as to preclude a reasonable search of the prior art by the Examiner; and, to request an amendment which clarifies the disclosure so that the Examiner may make a proper comparison of the claimed invention with the prior art.²⁴ This Letter consists of 3 pages: the cover page indicating the mailing date of the Letter which determines the due date of the required reply; and a 2-page Detailed Action containing the Examiner's rejections and objections to the September 1999 amendment in reply to the 8/31/99 final Office Action.²⁵

As for the 4/10/00 non-final Office Action, it contains the Examiner's response to Applicant's reply to the 10/8/99 Letter.²⁶ This 19-page document consists of a cover page with a mailing date that in turn determines the due date for the required reply; a 1-page Office Action Summary indicating, *inter alia*, disposition of the claims; and a 17-page Detailed Action which discusses the Examiner's review of Applicant's reply to the 10/8/99 Letter, as well as which claims are rejected, and which claims are objected to.²⁷ The 4/10/00 non-final Office Action concludes by stating that Applicant appears to be unfamiliar with the USPTO patent prosecuting procedure, and advising Applicant to retain the services of a patent attorney or agent, registered to practice before the USPTO, to prosecute this application on behalf of Applicant.²⁸

In light of the above descriptions of the 10/8/99 Letter and of the 4/10/00 non-final Office Action, it is not clear where the alleged "contradiction" exists, or how Applicant can possibly be confused by either of these correspondence. Had Applicant followed the pertinent USPTO rules and the procedures set forth in the MPEP²⁹ in prosecuting this application, as a "prudent and careful man" would have done in conducting "his most important business,"³⁰ Applicant would have at least

²³ 9/10/01 Petition, page 2, 1st paragraph. The petition also asserts that Applicant has timely responded to the 10/8/99 Letter. Since the cause of the abandonment at issue is the 4/10/00 non-final Office Action, the 10/8/99 Letter is irrelevant to the instant petition which requests revival of this abandoned application.

²⁴ 10/8/99 Letter, page 2, 1st & 2nd paragraphs under Specification.

²⁵ See note 3, supra.

²⁶ See note 5, supra.

²⁷ See Paper No. 26.

²⁸ Paper No. 26, page 18, Conclusion, 1st paragraph. The 7/26/01 Decision (page 3, Analysis of Issues, 1st paragraph) also made the same observation..

²⁹ This is the official interpretation of the patent statute and the USPTO rules.

³⁰ See Krahm v. Commissioner, note 20, *supra*, at 16747-16748.

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timely filed a proper reply to the 4/10/00 non-final Office Action as instructed by the Examiner.³¹ If Applicant indeed was "confused" by any irreconcilable "contradictions" between these two PTO communications as alleged in the instant petition, he could have and should have contacted the Examiner by telephone, as suggested in the 4/10/00 non-final Office Action.

In the instant case, the application became abandoned for either of the two reasons below:

- Applicant is unfamiliar with, or unaware of, the United States patent statute (35 U.S.C.) and the USPTO rules (37 CFR) that an outstanding USPTO Office action in an application requires timely submission of a proper reply or the application becomes abandoned upon expiration of the provided reply period, including any applicable extensions; or,
- Applicant is familiar with, and aware of, the reply requirements in the pertinent statute and rules, but deliberately chose not to file a reply, and instead chose to file the 6/2/00 Petition.

Applicant's unfamiliarity with the USPTO procedures for prosecuting patent applications was noted by the Examiner in the 4/10/00 non-final Office Action, and is further evidenced by the following:

- The instant petition states that the Examiner's "Aug. 1 letter" set a 3-month "statutory period,"³² when in fact this so-called "Aug. 1 letter" is the August 1, 2001 Notice of Abandonment, which is merely advisory and does not require any action on the part of Applicant, and which certainly does not include any reply period.³³

Contrary to the characterization in the instant petition, an applicant's delay in responding to an outstanding USPTO Office action due to unawareness of, or unfamiliarity with, the USPTO rules does not constitute "unavoidable" delay under 35 U.S.C. 133.³⁴

On the other hand, if Applicant deliberately chose not to file a proper reply to the 4/10/00 non-final Office Action, thereby deliberately allowed this application to become abandoned, the delay in subsequently filing the required reply cannot be considered "unintentional,"³⁵ let alone

³¹ The mere filing of the 6/2/00 Petition will not stay any period for reply that may be running against the application and/or save it from abandonment. See 37 CFR 1.181(f).

³² 9/10/01 Petition, page 1, lines 7-8.

³³ See Paper No. 30.

³⁴ Potter v. Dann, 201 U.S.P.Q. 574, 1978 U.S. Dist. LEXIS 17391, 17395 (D.D.C. 1978).

³⁵ In re Application G, note 22, *supra*, at 9.

"unavoidable."³⁶

Conclusion

In view of the above, the Office concludes that Petitioner has not carried his burden of showing to the satisfaction of the Commissioner that the delay in prosecuting this application was unavoidable. Accordingly, this application is not entitled to be revived.³⁷ The petition is thus dismissed.

A renewed petition under 37 CFR 1.137(a), should one be filed, must be accompanied by sufficient showing, as stated in item (3) above, that the entire delay in filing the "required reply" from the due date set forth in the 4/10/00 non-final Office action, i.e., July 10, 2000, until the filing of that renewed petition, was unavoidable.³⁸ This means that such a renewed petition, if desired, must be filed promptly to render the renewed petition grantable, if at all.³⁹

Alternatively, Applicant may file a petition to revive based on unintentional abandonment under 37 CFR 1.137(b).⁴⁰ For this application, such a petition would require a \$640 (small entity) petition fee,⁴¹ and a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.⁴² The filing of a petition under 37 CFR 1.137(b) must be filed promptly and cannot

³⁶ See MPEP section 711.03(c)(III)((C)(2) (Aug. 2001), citing *In re Maldaque*, note 14, *supra* (An intentional delay in seeking the revival of an abandoned application precludes a finding of unavoidable delay pursuant to 37 CFR 1.137(a)).

³⁷ *Winkler v. Ladd*, note 17, *supra*, at 559 (The Commissioner is authorized under 35 U.S.C. 133 to revive this application only upon showing that the delay was unavoidable.).

³⁸ The amendment submitted with the instant petition satisfies the "reply" requirement in item (1) above and does not need to be re-submitted unless further amendments are desired. No petition fee is required for a renewed petition under 37 CFR 1.137(a) for this application.

³⁹ An intentional delay in seeking the revival of an abandoned application precludes a finding of unavoidable delay pursuant to 37 CFR 1.137(a); *see* 711.03(c)(III)(C)(2) (Aug. 2001).

⁴⁰ Such petitions are less burdensome to file and are evaluated under the less stringent "unintentional delay" standard (MPEP 711.03(c)(III)(C) (Aug. 2001)). The dismissal or denial of a petition under 37 CFR 1.137(a) does not preclude an applicant from obtaining relief under 37 CFR 1.137(b) unless the decision dismissing or denying the 1.137(a) petition states otherwise (MPEP 711.03(c)(III)(C)(2) (Aug. 2001)).

⁴¹ 37 CFR 1.17(m). A fee is required for a petition under 37 CFR 1.137(b) because it is not a renewed petition for a dismissed or denied petition under 37 CFR 1.137(a).

⁴² Under 37 CFR 1.137(b), the Commissioner may require additional information where there is a question whether the delay, from the due date for the reply until the filing of a grantable petition, was

be intentionally delayed.⁴³ A blank form for a petition under 37 CFR 1.137(b) is attached. Should Applicant decide to file a petition under 37 CFR 1.137(b) by facsimile as instructed below in order to avoid delay in the mail, a credit card payment form for paying the petition fee is also attached.⁴⁴

Applicant's ultimate failure to carry the burden of proof to establish that the "entire" delay in timely prosecution of this application was "unavoidable" or at least "unintentional" may lead to the denial⁴⁵ of a petition under 37 CFR 1.137(a) or 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of this application.⁴⁶

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By facsimile: (703) 308-6916
 Attn: Office of Petitions

By hand: Office of Petitions
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unintentional. See also MPEP 711.03(c)(III)(F) (Aug. 2001), citing In re Application of G, note 21, *supra*, at 11 (A deliberate act is not "unintentional.").

⁴³ An intentional delay in seeking the revival of an abandoned application precludes a finding of unintentional delay pursuant to 37 CFR 1.137(b); see MPEP 711.03(c)(III)(D) (Aug. 2001). Thus, a person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. If Applicant intentionally delays the filing of such a petition, a statement that the entire delay was unintentional is inappropriate and may have an adverse effect when attempting to enforce any patent resulting from the application. MPEP 711.03(c)(III)(C) (Aug. 2001). Also see *Id.*

⁴⁴ Both the payment form and the petition form are available on www.uspto.gov.

⁴⁵ I.e., a final agency action within the meaning of 5 U.S.C. 704.

⁴⁶ MPEP 711.03(c)(III)(D) (Aug. 2001).

Telephone inquiries should be directed to Petitions Attorney RC Tang at (703) 308-0763.



Beverly M. Flanagan
Supervisory Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Attachments: 1. Form PTO/SB/64 (10-00)
2. Form PTO-2038 (02-2000)